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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,913	02/17/2004	Shing-Jung Wang	90295	8978
24628	7590	07/06/2006	EXAMINER	
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			PRATT, HELEN F	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

### Period for Reply

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/628502. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the claims do not exclude the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 5, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yajima (6,180,148) in view of California Wheat commission (evidenciary reference) and Schellhaass et al. (2005/0142273) and further in view of Seika (61-025455) and Shokuhin (57-013376).

Yajima discloses a noodle product containing a buckwheat flour, rice flour and gluten (abstract and col. 10, lines 59-65, col. 8, lines 14-19, col. 16, lines 44-58).

Claim 1 differs from the reference in the particular amount of protein in the wheat flour. However, California Wheat Commission discloses that durum wheat contains from 6 to 12% protein (1.Durum Wheat Analysis). Also, Schellhaass et al. disclose that gluten is known to be found in flour and various levels of gluten in the flour are known as disclosed by Schellhaass et al. (para (0018)). Therefore, it would have been obvious to add various amounts of gluten to flour or to use flours containing various amounts of wheat protein.

Claim 1 further differs from the reference in the use of at least 50% of a non-wheat cereal. However, the reference disclose that various cereal flours can be used in the composition as above. Ex. 31-4 discloses 6 kg of strong flour, which is assumed to be wheat flour, and 3 kg of buckwheat flour can be used (col. 10, lines 26-34). As the reference discloses other grain flours besides wheat (non-wheat cereal) it would have

been obvious to use rice or cornmeal in place of the buckwheat flour as disclosed by the reference and to use 50% of the non-wheat flour

Claims 4 and 5 further require particular kinds of non-wheat cereal and claims 1 and 5 oat cereal. Seika discloses that it is known to use wheat flour with rye, oat or barley (abstract). Shokuhin disclose that it is known to use barley flour, wheat flour, embro bud, and active gluten together (abstract). It would have been within the skill of the ordinary worker to choose which ever grain to use depending on the required nutritional qualities of the grain. Therefore, it would have been obvious to use the various known non- wheat grains in the composition of Yajima as shown by Seika and Shokuhin.

Claims 1, 16, 17 further require using more than 50% of oat flour. However, as it is known that oat flour is nutritious and that it must be supplemented with gluten in order to be used in a bakery product to give the product structure, then it would have been within the skill of the ordinary worker to use various amounts of oat flour depending on the nutritional value required as provided by oat flour. The discovery of an optimum value of a result effective variable is ordinarily within the skill of the art. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). In developing a flour composition, properties such as nutrition is important. It appears that the precise ingredients as well as their proportions affect the nutrition of the product, and thus are result effective variables which one of ordinary skill in the art would routinely optimize. Therefore, it would have been obvious to use more than 50% oat flour, since the product is also supplemented with gluten which provides structure for the product.

Claims 3, 6-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yakima as applied to the above claims, and further in view of Hunter, page 171.

Claim 3 further requires that the composition contain wheat gluten flour and wheat flour. However, wheat always contains gluten. At any rate, Hunter in Natural Foods discloses that it is known to use whole-wheat flour and gluten flour together (page 171, under "Wholewheat-Gluten Bread"). The protein in wheat flour is a crude protein, which is mostly gluten. Therefore, it would have been obvious to use gluten flour in the composition of Yakima along with wheat flour for their known functions of giving structure to the bread.

Claims 6-8 further require curdlan and further require it in particular amounts. Yajima discloses that it is known to use curdlan and common salt as in claims 9 and 10 (col. 10, lines 33 and 37). The particular amounts as in claim 10 are seen as being within the skill of the ordinary worker particularly as very small amounts can be used and the function of curdlan is well known as is salt. The discovery of an optimum value of a result effective variable is ordinarily within the skill of the art. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). In developing a flour product product, properties such as the structure of the dough product made from the flour are important. It appears that the precise ingredients as well as their proportions affect the structure of the dough, and thus are result effective variables which one of ordinary skill in the art would routinely optimize. Therefore, it would have been obvious to use particular amounts of curdlan and salt in the claimed composition.

The limitations of claim 11 have been disclosed above and are obvious for those reasons. Claim 12 further requires that a pasta noodle product is produced by calcendering. Claim 13 further requires extruding. Yajima discloses that the dough can be rolled and extruded (col. 10, lines 51-59 and col. 11, lines 60-65). However, these are method limitations in a composition claim and are not given weight. Claims 12 and 13 are also product-by-process claims. The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of such claims is based upon the product formed and not the method by which it was produced. See *In re Thorpe* 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the product-by-process claims. See *Ex parte Jungfer* 18 USPQ 2D 1796. Therefore, it would have been obvious to make a noodle as claimed.

The limitations of claims 14 and 15 have been disclosed above and are obvious for those reasons.

Claims 16 and 17 are to the method of making a dough by adding water to the composition whose limitations have been disclosed above. Yajima discloses adding water to a mixture of flour, starch, oils and gliadin (a gluten) (col. 23, lines 22-27). Therefore, it would have been obvious to add water to a flour composition to make a dough as shown by Yamima.

Claim 18 further requires extruding the dough to make a pasta noodle. Extruding is seen as conventional as disclosed in applicants' specification on pages 6-10, as is calendaring in claim 19.

The addition of curdlan gum as in claim 20 has been disclosed in the composition claims. Therefore, it would have been obvious to add curdlan to the composition.

Claims 1, 3-5, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai et al. (5,384,136) in view of California Wheat Commission (evidenciary reference).

Lai et al. disclose that it is known to make a dough product with added gluten (abstract) and to use wheat flour and other flours such as rye, corn, oats and tricale (col. 10, lines 18-29). Claims 1-5, 11 differ from the reference in the use of 6-10% protein in the wheat flour and gluten flour. The reference teaches that when no wheat flour is used, gluten can be added to give the product strength, stability and height. It is known that the other flours do not contain gluten which is found only in wheat flour. Wheat flour is known to contain from 6-20% protein as disclosed by California Wheat Commission. The particular amount of oat flour is seen to have been within the skill of the ordinary worker, as an acceptable product can be made with added gluten, since oats do not contain much gluten which is necessary to provide structure to the bread composition. Therefore, it would have been obvious to use oat flour if gluten is added because the added gluten will make up for the non-gluten containing oat flours.

#### ARGUMENTS

Applicant's arguments filed 5-30-06 have been fully considered but they are not persuasive. Applicants argue that the references do not contain a composition



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containing at least 50% oat flour. However, this composition has been shown above. It would have been obvious to add whatever amount of oat flour that applicants required, since the structure provided by gluten is added from another source.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Hp 6-28-06

*H. Pratt*  
HELEN PRATT  
PRIMARY EXAMINER